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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,656	09/18/2000	Paul L. Dong	3644P2209	3803

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EXAMINER

BHAT, NINA NMN

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,656

Applicant(s)

DONG, PAUL L.

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

1. Claims 11-12 and 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claims these claims applicant has recited specific Chinese herbs, which have been spelled phonetically, which is not described in a way to enable one skilled in the art to make and/or use the invention. The phonetic spelling of Chinese herbs does not lend one of ordinary skill in the art to make the soup because the phonetic spelling does not correspond to herbs where there is recognized spelling which has been used by Western Societies or English speaking societies. Please note the Prior art submitted. Further, in China there are at least two dialects the Mandarin pronunciation or the Cantonese pronunciation. For example, "Beijing" or "Peking". The phonetic spelling would be different based on the dialect. Applicant is suggested to look at the references being sent and correlate with conventionally known names of the Chinese herbs or to use the Chinese spelling of the herbs which can be translated by a translator or to use the botanical names of the herbs being used in the soup.
2. The phonetically spelled Chinese herbs in the above mentioned claims is precluding search of these claims and hindering prosecution.
3. Claims 11-12 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant should not recite in the claims

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"(phonetically spelled" in the Markush group. Applicant should just recited the specific herbs and avoid the recitation "phonetically spelled".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Su. [CN1094243 Derwent Abstract only]

Su teaches making an extract of nine Chinese herbal medicines which include lotus seed, stat, fragrant solomon seal rhizome, coix seed, lily, fruit of Chinese wolf-berry, root of balloon flower, Chinese yam, ginseng or codonopsis pilsula. The extract can be added with pig bone, spare ribs, chicken flesh, other spices such as sugar can be added. The proportions although not specifically recited would read directly on applicant's range of ingredients inherently. The soup provides improved health after adopting a regime of eating the soup. The soup purports to replenishing the essence of life, tonifying the kidney, nourishing the heart, tonifying qi, whetting the appetite and reducing blood lipids.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sun. Sun teaches herbal treatment of malignancies in humans, which include preparation of a soup, or coked aqueous extract wherein Chinese herbs are boiled in water to form an extract the extracted is then cooked with meat or chine as soup for at least 5 minutes. Specifically, the soup includes Chinese herbs, which include letinus edode, mung bean, scutellaria barbata, and hedyotis diffusa. Sun teaches that the herbs should not been eaten but should be administered as a soup. The herbs are known antioxidant ability as well as will reduce the growth of some tumors. The specific Chinese herbs used in the soup as described by Sun is mung bean and black mushroom.[Note Column 1, lines 60-68, Column 2, lines 1-55, Column 3, lines 30-56, column 6, lines 39-68 to Column 7, line 30]

Sun does not teach the specific proportions of soup ingredients however, the concept of providing Chinese herbs in a soup containing a broth, meat and herbal extracts for promoting health and wellness has been taught. To provide a soup which includes flavors, meats, and Chinese herbs, alcohol in applicant's specific proportions would have been obvious to one having ordinary skill in the art at the time the invention

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was made because to optimize the compositional ingredients which provide best results would have been obvious since applicant's basic concept of adding Chinese herbs to a soup composition which is orally administered to promote health and wellness has been fully taught and suggested by sun thus rendering applicant's invention as a whole obvious.

9. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaynor et al.

Gaynor et al. teaches a green nutritional powder which is used in making beverages or soups which are orally administered to a humans to boost energy and associated feelings of well being when the mixture is taken as part of a regular regimen to supplement normal nutritional intakes of humans.[Note abstract]. Specifically, Gaynor et al. teach that the homeopathic literature is replete with formula for curatives an palliative for "every imaginable injury and diseases". Specifically, Gaynor et al. teach that in Chinese diets, ginseng used in chicken-ginseng soup or a snack, which includes ginseng and honey, is known for the prevention of cancer and to promote wellness. Other commonly known herbs such as rosemary are known antioxidants. Soybeans are also known are high in folic acids and glycosides, saponins and isofalvonoids known to be cancer preventing agents. The green nutritional powder comprises blue green algae, organic green juice powders, Asian herbs, Western herbs, soy isoflavones, essential fatty acids and cruciferous vegetable extracts. Specifically, a nutrition drink or soup can be made which uses the green powder which can be added to tomato juice,

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added to water or fruit juice.[Column 2 lines 34-55; Column 3, lines 25 et seq.] The green powder can be made into a food paste and or spread.

It would have been obvious to one having ordinary skill in the art from reading Gaynor to employ the powdered nutritional supplement into a soup composition, which includes broth or water, meat and flavorings and alcohol to provide a nutritional soup, which would provide over wellness and energy boosting upon ingestion. The concept of using a plurality of Asian and western herbs for the promotion of wellness as a food supplement which can be added to water, juice, made into a paste or spread has been fully taught to use the food supplement in a soup composition renders applicant's invention as a whole obvious absent criticality in showing.

10. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keiko JP 2001078710. [English Abstract Only]

Keiko teaches the invention substantially as claimed.

Keiko teaches a soup stock soy sauce composition which includes Chinese medicinal herbs which can also include flavorings (soy sauce), dried bonito which is a dried fish flakes, water which is made into a soup stock wherein the consumer can add addition cooked food, bean cured, noodles which when consumed can be used in maintaining the health, increase the immune strength decreasing stress related problems which include herbs such as panax ginseng as well as other Asian herbs and spices.[Note the abstract].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a soup w which contains natural herbs which is halt for a

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consumer's diet and to increase the consumer's energy level which includes a meat product, liquid, spices and Chinese herbs from the teachings Keiko. To provide applicant's specific proportions of ingredients which provide best results renders the claims obvious because the prior art to Keiko basically a soup stock which includes Chinese herbs, water, meat and spices/seasonings which can be used a stock and wherein other food ingredients can be added thereto thus rendering applicant's invention as a whole obvious to one having ordinary skill in the art. Applicant's soup composition for promoting wellness, health and energy has been specifically taught and suggested by Keiko.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hsu et al. teach providing a nasal spray for treating fever/cold and its preparation, which includes a number of vitamins as well as extracts of Chinese herbs. Yang CN 1328788A [abstract only] teach an edible wild herb soup and process of making the soup. Yang Z CN 1198944[abstract only] teach a homeopathic medicine which includes 7 Chinese medicinal materials. The Pulse of Orient Medicine teaches Natural Chinese herbs and Chinese Herbal Medicines. Chinese Medicine Acupuncture and Herbs teach various recipes into the use of Chinese herbs. Cathy Herbal Laboratories teaching treating allergic diseases with various Chinese herbs.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat
Primary Examiner
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May 3, 2003